

DAC

[Handwritten initials]



Docket No. 2685/113592

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Jocelyn Cloutier et al.
Serial No.: 09/736,430
Filing Date: December 15, 2000
For: Synchronous Transmission of Data with
Network Remote Control

Art Unit: 2643
Examiner: Not Assigned

RECEIVED

APR 18 2001

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Washington D.C. 20231

PETITION FOR FILING BY OTHER THAN ALL THE INVENTORS UNDER
37 C.F.R. 1.47(a)

S I R:

Applicants, Allen E. Milewski and Thomas M. Smith, hereby petition the Assistant Commissioner to accept the filing of the above-identified patent application by other than all of the inventors.

An affidavit and an exhibit are attached hereto providing proof of the pertinent facts concerning the refusal of the co-inventor to join in the present application for patent.

The name and last-known address of the co-inventor refusing to join in this application is as follows:

Jocelyn Cloutier
770 18th Avenue
Menlo Park, California 94025

The invention was developed in conjunction with and the authorization of AT&T Corp. by Jocelyn Cloutier, Allen E. Milewski and Thomas M. Smith, each of whom were employees of AT&T Corp. at the time of the invention disclosed in the above-referenced patent application.

09736430
09736430
04/17/2001 CNGUYEN 00000006 110600
01 FC:122 130.00 CH

Upon information and belief, based on the precedent which will be discussed below, AT&T is entitled to clear title to the invention and to the above-identified patent application and any patent which issues thereon.

The Supreme Court of the United States in *Solomons v. United States* 137 U.S. 342, 346 (1890) held:

If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto as against his employer. That which has been employed and paid to accomplish becomes, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to his inventive powers, and that which they are able to accomplish, he was sold in advance of his employer.

It is clear that an employee who is paid to develop an invention comes within the scope of the language cited. See *In re Hobbs*, 136 U.S.P.Q 489 (Atomic Energy Comm. Pat. Comp. Bd. 1963).

Because Jocelyn Cloutier was employed by AT&T Corp. at the time of the invention, and was paid compensation to jointly develop, with Allen E. Milewski and Thomas M. Smith the method and system for synchronous transmission of data with network remote control, the invention belongs to AT&T Corp., and each individual inventor who contributed to the development of the method and system has a duty to jointly execute an application for patent covering the method and system and to assign the invention, patent application, and any patent which issues to AT&T Corp.

Allen E. Milewski and Thomas M. Smith have assigned their rights in the subject U.S. patent application to AT&T Corp. Assignee's counsel contacted Jocelyn Cloutier in a letter sent on October 19, 2000 that included a complete copy of the application papers (specification, claims, drawings and an oath and declaration), and requested that the declaration/oath and assignment be executed by Jocelyn Cloutier and be returned to assignee's counsel to complete the filing of this application. A copy of the letter is attached to this petition as Exhibit A. Further, as stated in the attached affidavit, Allen E. Milewski on numerous occasions during the period following the filing of the application contacted Mr. Cloutier to obtain Mr. Cloutier's executed declaration/oath and assignment. Despite these efforts, neither the executed

PE JG174
APR 13 2001
TRADEMARK OFFICE

declaration/oath, that the executed assignment has been received from Mr. Cloutier, even though an inordinately long amount of time has elapsed following the mailing of the letter of October 19, 2000.


The conduct of Jocelyn Cloutier in view of the facts stated above supports a conclusion under 37 C.F.R. § 1.47 that Jocelyn Cloutier has refused to sign the declaration/oath. Because of the refusal of co-inventor Jocelyn Cloutier to execute the papers required for filing the present patent application, Allen E. Milewski and Thomas M. Smith are believed to be entitled to make such application on behalf of and as agent for their co-inventor Jocelyn Cloutier.

This Petition is accompanied by authorization to charge the requisite fee of \$130 under 37 C.F.R. § 1.17(i) to Deposit Account 11-0600. A duplicate copy of this paper is attached for that purpose. In addition, the Commissioner is authorized to charge any underpayment, or additional fees to Deposit Account 11-0600.

It is respectfully submitted that the requirements for filling this application under 35 U.S.C. § 116 have been met.

Respectfully submitted,

Date 4/13/01

By 
Sinan Utku
Reg. No. 46,137

KENYON & KENYON
1500 K Street, NW - Suite 700
Washington, DC 20005
telephone: 202/220-4200/facsimile: 202/220-4201

RECEIVED

APR 18 2001

OFFICE OF PETITIONS